



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/825,561 | 04/03/2001 | Cindy A. Sprecher | 00-22 | 2838 |

7590 03/05/2003

Jennifer K. Johnson, J.D.
ZymoGenetics, Inc.
1201 Eastlake Avenue East
Seattle, WA 98102

EXAMINER

LI, RUIXIANG

ART UNIT PAPER NUMBER

1646

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|--------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/825,561 | SPRECHER | |
| | Examiner | Art Unit | |
| | Ruixiang Li | 1646 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 06/17/2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24,31-33 and 35-71 is/are pending in the application.
 - 4a) Of the above claim(s) 1-24,38-47 and 53-60 is/are withdrawn from consideration.
- 5) Claim(s) 48 and 61 is/are allowed.
- 6) Claim(s) 31,35,51 and 52 is/are rejected.
- 7) Claim(s) 32,33,36, 37, 49, 50, and 62-71 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

| | |
|---|--|
| <ol style="list-style-type: none"> 1)<input type="checkbox"/> Notice of References Cited (PTO-892) 2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3)<input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>15</u>. | <ol style="list-style-type: none"> 4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. 5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6)<input type="checkbox"/> Other: _____. |
|---|--|

DETAILED ACTION

I. Status of Application, Amendments, and/or Claims

Applicants' Response filed on January 21, 2003 (Paper No. 13) has been entered in full. Claims 31, 33, 37, and 49 have been amended. Claims 61-71 have been added. Claims 1-24, 31-33, and 35-71 are pending. Claims 31-33, 35-37, 48-52, and 61-71 are currently under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

II. Withdrawn Objections and/or Rejections

The rejection of claims 31-33, 35-37, and 48-52 under 35 U.S.C. 102 (a), as set forth at pages 3-4 of the previous Office Action (Paper No. 12, July 11, 2002), has been withdrawn in view of applicants' Declaration under 37 CFR §1.131.

The objection of 31-33, 37, 49, 50, and 52 for minor informalities, as set forth at page 4 of the previous Office Action (Paper No. 12, July 11, 2002), has been withdrawn in view of applicants' amendment to the claims

III. Claim Rejections Under 35 U. S. C. § 102 (e)

The rejection of claims 31 and 35 under 35 U.S.C. 102 (e), as set forth at page 3 of the previous Office Action (Paper No. 12, July 11, 2002), remains.

Claims 51 and 52 are also rejected under 35 U.S.C. 102 (e). Claim 51 depends upon claim 35, whereas claim 52 depends upon claim 31. Novak et al. teach Zalpha11 receptor polypeptide containing C-terminal GluGlu (EE) tags (See, e.g., Examples 10 and 11). Thus, the reference of Novak et al. meets the limitations of claims 51 and 52.

Applicants argue, citing a number of case laws, (i) that the reference by Novak et al. does not teach Zalpha11 receptor heterodimers or multimers and every element of the claims; and (ii) that the reference by Novak et al. does not teach the Zalpha11 receptor, by its nature, forms a heterodimeric or multimeric receptor complex.

This has been fully considered but is not deemed to be persuasive for the following reasons, as well as for the reasons set forth at page 3 of the previous Office Action (Paper No. 12, July 11, 2002).

First, as Applicants have acknowledged in the response (e.g., line 13 of page 7), the Zalpha11 cytokine receptor of Novak et al. form homodimers. It is recognized in the art that “homodimer of a receptor” is considered as a multimer form of the receptor. The instant specification (lines 17-18 of page 12) also illustrates the term “multimeric” by giving the examples including PDGF receptor, which is well-known in the art to form homodimer. Thus, since Novak et al. teach that Zalpha11 cytokine receptor form homodimers, i.e., multimers, the reference of Novak et al reads on the instant claims.

Secondly, while Novak et al. states that “...although no receptor subunit corresponding to IL-2R α has yet been identified, ...” (line 15 of column 8), such a statement does not, in any way, teach that a receptor subunit corresponding to IL-2R α or any other receptor subunit do not exist in nature.

Finally and most importantly, Novak et al. teach the exactly same Zalpha11 cytokine receptor recited by the instant claims. Regardless whether Novak et al. teach the Zalpha11 cytokine receptor forms a heterodimeric or multimeric receptor complex, the functions and activities of Zalpha11 cytokine receptor are inherent in the structure of the molecule. Functions depend upon structure, the principle of which is well-known in the art. Newly discovered properties of a compound known in the art do not render the compound novel and thus patentable. Since the instant claims are drawn to the same Zalpha11 cytokine receptor, the reference of Novak et al. reads on the claims.

IV. Claim Objections

- (i) Claims 32, 33, 36, and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
- (ii) Claims 49-52 are 62-71 are objected to because each independent claim recites the word "an", which should be "the".
- (iii) Claim 67 is objected because it recites the limitation "An isolated polypeptide" in claim 66. There is insufficient antecedent basis for this limitation in the claim.
- (iii) Claim 71 is objected because it recites the limitation "An isolated polypeptide" in claim 70. There is insufficient antecedent basis for this limitation in the claim.

V. Conclusion

Claims 48 and 61 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruixiang Li whose telephone number is (703) 306-0282. The examiner can normally be reached on Monday-Friday, 8:30 am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564. The fax phone number for this Group is (703) 305-3014 or (703) 308-4242.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Ruixiang Li
Examiner
March 3, 2003